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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 0108-0245	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>11 August 2008</u> Signature <u>/John J. Oskorep/</u> Typed or printed name <u>John J. Oskorep, Esq.</u>		Application Number 10/789,556 First Named Inventor Burns Art Unit 2134	Filed 27 February 2004 Examiner Bayou, Yonas A.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. 41,234 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>/John J. Oskorep/</u> _____ Signature <u>John J. Oskorep, Esq.</u> _____ Typed or printed name <u>312 222-1860</u> _____ Telephone number <u>11 August 2008</u> _____ Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Burns)	Group No.: 2134
)	
Serial No.: 10/789,556)	Examiner: Bayou, Yonas A.
)	
Filing Date: 27 February 2004)	Docket No.: 0108-0245
)	

For: "METHODS AND APPARATUS FOR AUTOMATICALLY GROUPING
USER-SPECIFIC INFORMATION IN A MOBILE STATION"

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Applicant respectfully submits this *Pre-Appeal Brief Request For Review* in response to the Final Office Action mailed on 27 March 2008, and the subsequent Advisory Action mailed on 11 July 2008, for the above-identified patent application.

I. Summary of Disclosure. Methods and apparatus for use in automatically grouping user-specific information items are provided in a mobile station. A processor of the mobile station is adapted to automatically group user-specific information items in response to identifying a "single" trigger signal. The trigger signal may be, for example, a timer expiration, or a data item update by the user. The automatic grouping of user-specific information items involves the following acts which are responsive to this trigger signal. A first user-specific information item (e.g. e-mail address of "John Doe") is read from a first file of the mobile station, and stored in a central user information file or a message of the mobile station. The acts of reading and storing are then *repeated* for at least a second user-specific information item (e.g. personal identification number of "John Doe") from a second file of the mobile station, so that the first and the second user-specific information items

are grouped together as user information in the central user information file or the message of the mobile station.

Advantageously, the mobile station is adapted to provide an automatic grouping of data items from already-existing disparate files and locations in the mobile station, storing such items in the same central user information file or message in response to a single trigger signal. This technique takes advantage of the fact that current/updated user-specific information items are already present and stored in different files and applications of the mobile station, and therefore no excessive data inputting by the user is necessary to achieve the desired results.

II. Claim Rejections. In the Office Action mailed on 27 March 2008, the Examiner rejected claims 1-28 under 35 U.S.C. § 102(b) as being anticipated by Jin (U.S. Patent Application Publication No. US2002/0084888A1). In addition, the Examiner rejected dependent claims 9, 19, 21, and 28 under 35 U.S.C. § 103(a) as being obvious over Jin in view of Minborg (U.S. Patent No. 6,977,909).

III. Clear Errors In The Examiner's Rejections. The Examiner's rejections of the present claims fail specifically due to the following clear errors as described below:

1. Jin Fails To Teach Or Suggest The Act Of "Repeating" Which Is Performed "In Response To A Trigger Signal" As Claimed.

The Examiner has committed clear error because the relied upon art (i.e. the Jin reference) fails to teach or suggest the acts of "reading," "storing," and "repeating" which are performed "automatically" ... "in response to a trigger signal" as claimed in claims 1-22. Please refer to pages 9-11 of the Amendment of 26 June 2008.

In general, the Jin reference describes a system for sending and receiving personal information using a mobile terminal. A personal information is sent using a short message service with an attached identification information. This involves setting the mobile terminal to a personal information sending mode, and inputting personal information data by the user for transmission. As apparent, the Jin reference requires the user to manually enter the multiple user information items through an application. This is not what is claimed and generally illustrates the clear error made by the Examiner.

The Examiner's references to the Jin reference illustrate the details regarding this clear error. For the Examiner's alleged teaching of the claimed "in response to a trigger signal, automatically grouping" step, the Examiner recites to paragraph 31 of the Jin reference. In paragraph 31 of the Jin reference, it is taught that the user inputs the phone number of the receiving mobile terminal to which the user wants to transmit the personal information. It is further taught that the user can either input this phone number manually or automatically. Thus, the Examiner alleges that the user inputting of the phone number of the receiving mobile terminal is the "trigger signal" which causes some "automatic grouping."

However, the Examiner is wrong. If the user input of the phone number of the receiving mobile terminal in the Jin reference were to be treated as a "trigger signal", then there would only be a single set – not two sets - of "reading" and "storing" actions that would occur subsequently in response to the alleged trigger signal (i.e. the previous data has already been entered by the user, prior to the alleged trigger signal). There is no "repeating" action. In the present claims, the acts of "reading," "storing," and "repeating" (i.e. repeating the reading and storing for a second item) are performed in response to the same trigger signal. Thus, the Examiner's argument with respect to the Jin reference fails and this is clear error.

Further, regarding the Examiner's alleged demonstration of the claimed "[first] reading" step, the Examiner recites to FIGs. 4a-4f of the Jin reference. In FIGs. 4a-4f of the Jin reference, the manual inputting process for data by the user is illustrated. The manual user data entry of FIGs. 4a-4f, however, cannot be treated as the "[first] reading" step as the Examiner alleges. If the manual user data entry of FIGs. 4a-4f were to be treated as the "[first] reading" step, then the Examiner cannot reasonably argue that the user inputting of the phone number of the receiving mobile terminal (see paragraph 31 of the Jin reference) is the alleged trigger signal. The obvious reason is because the user inputting of the phone number *occurs after* the manual inputting process of the data by the user. A trigger signal which causes an alleged multi-step automatic grouping process cannot come *after* the automatic grouping process. Again, in the present claims, the acts of "reading," "storing,"

and "repeating" (i.e. repeating the reading and storing steps for a second item) are performed in response to the same trigger signal. Thus, the Examiner's additional argument with respect to the Jin reference fails again and this is clear error.

To further illustrate the Examiner's deficiencies by dependent claims, the alleged teaching of the claimed "the trigger signal [being] produced in response to a user input request for the user information" (see e.g. claims 10 and 20), the Examiner makes reference to paragraph 42 of the Jin reference and states that "the command 'confirm' icon do the act of reading, storing, and repeating." Again, if the manual user data entry of the Jin reference were to be treated as the trigger signal, then the Examiner cannot also argue that the user inputting of the phone number of the receiving mobile terminal (see paragraph 31 of the Jin reference) is the alleged trigger signal. Again, in the present claims, the acts of "reading," "storing," and "repeating" are performed in response to the same trigger signal.

As apparent, the Examiner cannot give any single example in the Jin reference where the claimed actions are taught, and this is clear error.

2. The Examiner Has Not Argued Or Debated The Applicant's Proper Interpretation Of The Claimed Limitations.

The Examiner must interpret the claims broadly – but only as broadly as is reasonable. To interpret the claims in a different way, other than as presented as understood by those ordinarily skilled in the art, would be unreasonable. In the present case, there is no argument or debate regarding the proper interpretation of the claimed limitations. To help illustrate, the Applicants list method claim 1 below. Method claim 1 recites:

1. In a mobile station, a method of automatically grouping user-specific information items comprising the acts of:
 - in response to a trigger signal, automatically grouping the user-specific information items by a processor of the mobile station by:
 - reading a first user-specific information item from a first file of the mobile station;
 - storing the first user-specific information item in a user information file or a message of the mobile station; and
 - repeating the acts of reading and storing for at least a second user-specific information item from a second file of the mobile station, so that the first and the second user-specific information

items are grouped together as user information in the user information file or the message of the mobile station.

As apparent, the recited acts of "reading," "storing," and "repeating" are *indented* to the right of the "automatically grouping" recitation – all of which are performed "in response to a trigger signal." Thus, the claims have been formatted and otherwise fashioned so that the acts of "reading," "storing," and "repeating" *structurally* fall under the purview of the single triggering act. Proper interpretation thus requires that the acts of "reading" and "storing" of a first user-specific information item, as well as the acts of "reading" and "storing" again (i.e. the repeating act) of a second user-specific information item, are performed in response to the *single* trigger signal in the automatic grouping of user-specific information items. Please refer to pages 7-8 of the Amendment of 26 June 2008.

The Examiner has not argued against or debated the Applicant's proper claim interpretation in the Final Office Action or the Advisory Action. Therefore, there is no interpretation issue for presentation to the board. If the Examiner alleges otherwise, the Examiner has failed to argue and articulate the same, which is clear error and unjustifiable for presentation on appeal.

The Applicant respectfully requests the panel of Examiners to consider the present Request and arguments with respect to the clear errors made by the Examiner, and take appropriate action based on the same. Thank you.

Respectfully submitted,

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